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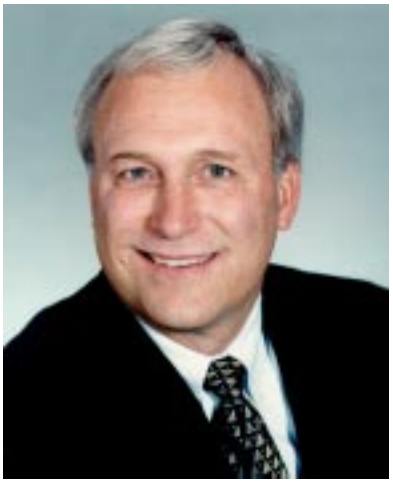
Inside:



In Touch

With the Under Secretary for IP

Nicholas P. Godici
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

With spring approaching, this March is a particularly active time at the USPTO. This month the USPTO will be publishing the first patent application documents. The publication of patent applications, commonly referred to as PGPub (**P**re-**G**rant **Pub**lication), is one of the changes brought on by the enactment of the *American Inventor's Protection Act of 1999*. The publishing of these qualifying patent application documents is an historic event in the over 210-year history of the United States Patent system. This information will not only expand the public knowledge of technology, but will significantly increase the volume of publications that the USPTO disseminates.

We held our inaugural Business Method Partnership meeting the first of this month. It was the first in a series of partnership meetings as a result of the Business Method Patent Initiative Action Plan. This is part of a continuing effort by the USPTO to work with our customers to share information and discuss issues on important topics. While the business method patent area has been the focus of quite a bit of attention, we have customer outreach efforts and partnerships in all of our patent technology centers. Besides the feed back we get through our annual customer surveys, we use these partnerships and outreach meetings to hear from our customers. I encourage all of our customers to participate in these types of outreach efforts.

You can't pick up, or log on to, a newspaper or magazine without seeing an article on the human genome. Our recently finalized utility guidelines, discussed in this edition of the *USPTO Today*, have helped to clarify the USPTO position concerning the legality of patenting genes and gene fragments.

Another popular topic has been the registration of domain names as trademarks. This month's edition lays out some statistics regarding "dot-com" trademark filings.

E-Commerce Major Focus...

New Secretary Lays Out Administration's Vision for Commerce Department

by Ruth Ann Nyblod, Office of Public Affairs

The Crystal Forum overflowed with USPTO employees on January 29, attempting to get a glimpse of the new secretary of commerce and an idea of what their new boss may be like.

Donald L. Evans, recently appointed by President Bush, confirmed by the Senate, and sworn-in as the 34th secretary of commerce, made his rounds among the Commerce Department agencies to introduce himself to his employees and share his thoughts on the future. Evans now leads about 132,000 employees of which over 6,000 work at the USPTO.

Secretary Evans has an optimistic and hopeful attitude for America and the department. He sees a vital role for commerce as the country moves away from an industrial-based economy to a knowledge-based economy and where issuing patents is most important. Evans' focus will be on e-commerce wherein the Commerce Department will be at the leading edge.

"My friend, President George W. Bush, has a vision for America and this department," said Evans. "It is a vision where our e-commerce entrepreneurs are freed from excessive regulation so they can dream and build. We look forward to leading the administration's e-commerce efforts to foster growth in our knowledge-based economy by our activities at ...PTO...."

Top: A patent model for the secretary's office, from one mechanical engineer to another.... Acting Under Secretary Godici presented to Secretary Evans a patent model of a rotary steam valve patented December 14, 1858, by John L. Whetstone of Cincinnati, Ohio.

Below: Acting Under Secretary Godici (left) and Commissioner Chasser presented to Secretary Evans a poster showing a chronology of Campbell's soup trademarks from Abe Lincoln's time to today. Secretary Evans confided that his Sunday evening meal is always Campbell's tomato soup and popcorn.

The Secretary stressed that while the world rapidly moves to expand its markets around the globe, intellectual property is critical to advancing economic certainty. Indeed. This year the USPTO will process over 300,000 patent applications and over 400,000 trademark applications. The USPTO's role is to ensure applicants receive the highest quality service and products to protect their investments, and e-commerce has been a priority to achieve that quality.

To his audience of USPTO employees, Secretary Evans bestowed his personal thanks for the important jobs they do, and for serving America, adding that "all America should thank you."

About Secretary Evans:

(from the Department of Commerce Web site)

Born in Houston, Texas in 1946, Donald Louis Evans attended the University of Texas at Austin, receiving a Bachelor of Science degree in Mechanical Engineering in 1969 and a Master of Business Administration in 1973. While at UT, he was a member of Omicron Delta Kappa and the Sigma Alpha Epsilon fraternity. Mr. Evans was also a member of the Texas Cowboys, a campus honorary service organization.

In 1975, Mr. Evans joined Tom Brown, Inc., a large independent energy company now based in Denver, Colorado, where he served as Chairman of the Board of Directors and Chief Executive Officer of the Company.

In February of 1995, Mr. Evans was appointed by Governor George W. Bush to the Board of Regents of the University of Texas System. In February 1997, he was elected to serve as Chairman of the Board and served for two consecutive two-year terms.

Mr. Evans served as Chairman of the Bush/Cheney 2000 campaign, and was active in Governor Bush's two successful gubernatorial campaigns in 1994 and 1998. In addition, he was Chairman of the 1995 Texas Inaugural Committee for Governor George W. Bush.

He is married to Susan Marinis Evans. They have two grown daughters and an eleven-year old son.

USPTO Holds Inaugural Business Methods Partnership Meeting

by Wynn Coggins, Industry Outreach Coordinator, Technology Center 2100

On March 1, 2001, Technology Center 2100 held its inaugural business methods partnership meeting at the USPTO. Approximately 90 representatives from the business and legal community, trade associations, and academia attended.

The meeting was the first in a series of partnership meetings that will occur as part of the Business Method Patent Initiative Action Plan announced last March by former Under Secretary Q. Todd Dickinson. The action plan includes initiatives on outreach, and specifically addressed establishing formal customer partnerships with the software, Internet, and electronic commerce industries. These partnerships are to provide a forum to discuss mutual concerns, problems and possible solutions, and to share USPTO operational efforts in the business methods technology area.

John Love, director of Technology Center 2100, and I opened the meeting. Acting Under Secretary Nicholas Godici, welcomed everyone and updated the audience on USPTO's progress in the training and quality initiatives announced in the Action Plan. He emphasized the importance of continuing the partnership efforts between the USPTO and industry, discussed the formation of new Technology Center 2100, and then briefly outlined the day's agenda.

The first portion of the meeting included an in-depth update on the business methods initiatives including mandatory searching requirements and search tools, the non-patent literature Web pages available to the examiners, examiner training, current staffing levels in Class 705, and filing information specific to Class 705. An overview of new rule 37 CFR 1.105 was also presented. John Love and supervisory patent examiners Tariq Hafiz, James Trammell, and Vincent Millin lead the presentation.

The second portion of the meeting included break-out sessions in which participants were asked to identify what business method-related key drivers or issues need attention, and openly discuss those issues. Participants were also asked to give their own ideas on the content and format of future partnership meetings.

The participants identified and reported back on the top key drivers. They were:

1. Issues surrounding the patenting of non-computer implemented business methods.
2. Pendency in Class 705 is a concern.
3. Are there plans for a "second pair of eyes" in other areas of the USPTO?
4. Can a third party consultant be brought in to create prior art databases?
5. Cost of prosecution under the new rules.
6. Rule 105 places a potential burden on the applicant.
7. There should not be different legal standards across classes.
8. Will a template be developed for other areas of the USPTO?

A summary of the topics discussed at this meeting will be posted the end of March on the new business methods Web page. A link to this site will be available on the USPTO Web page at www.uspto.gov.

Final Examination Guidelines Released for Utility and Written Description

by Brian R. Stanton, Practice Specialist, Technology Center 1600

On January 5, 2001, the United States Patent and Trademark Office published the final version of the examination guidelines to be used by patent examiners when making determinations regarding compliance with the utility requirement of 35 U.S.C. § 101 and the written description requirement of 35 U.S.C. § 112, first paragraph. These guidelines have been over three years in the making and represent a significant step in the consolidation and clarification of patentability standards.

The United States Constitution, Art. 1, Sec. 8, authorizes Congress to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." This statement yields broad authority to the establishment of a system for providing this reward, the patent system. To this end, Congress enacted a singular set of laws applicable to all technologies. These laws provide a stable platform for administration of the patent system. Emerging technologies, however, represent a major challenge to the application of

these laws. In an effort to provide the highest quality and greatest consistency in the patent examination process, the USPTO promulgated examination guidelines to assist both patent examiners and practitioners in the application of the utility requirement set forth in 35 U.S.C. § 101 and the written description requirement of 35 U.S.C. § 112, first paragraph.

Anything under the sun that is made by man including a non-naturally occurring manufacture or composition of matter that is the product of human ingenuity is eligible for patenting. However, 35 U.S.C. § 101 of the patent statute requires that in order for an invention to be patentable, it must be, among other things, useful. This is part of the *quid pro quo* of the patent system. A patent is not a hunting license. Instead, it is a reward, the successful conclusion of the inventive process.

To address the question as to what is required for an invention to be considered useful, the USPTO has established a set of examination guidelines to be used by patent examiners in making a determination as to whether or not any particular invention has met the requirements of utility as required by law. The final guidelines reflected many well reasoned public comments. These guidelines emphasize that an invention is required to be supported by at least one specific, substantial, and credible or a well-established utility.

A *specific* utility is one that is particular to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention. For example, if the only disclosed "use" of a polynucleotide is as a "gene probe" or "chromosome marker," and the specific DNA target is not disclosed, that nucleotide would not be considered to have a specific utility. Similarly, a general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed.

A *substantial* utility is one that defines a "real world" context of use. Utilities that would require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. The guidelines make it clear that a claimed invention must have specific and substantial utility that excludes "throw-away," "insubstantial," or "nonspecific" utilities such as use of a complex invention as landfill. However, it is noted that no matter what asserted utility is present in an application for patent, the assertion is considered based upon the facts present in an individual application. For example, an assertion of the use of a cancer associated protein as a nutritional animal food supplement would not usually be considered to be substantial. However, if a patent application clearly set forth that a protein had been designed

to provide particular nutritional support and that this was the basis of the use of the disclosed protein, the "nutritional animal food supplement" utility might be sufficient to satisfy the utility requirement.

The third prong of the utility requirement is that an asserted utility be *credible*. An asserted utility *will be* considered to be credible unless (a) the logic underlying the assertion is seriously flawed, or (b) the facts upon which the assertion is based are inconsistent with the logic underlying the assertion. For example, it is unlikely that absent evidence, a general cancer or AIDS vaccine would be found credible to one skilled in the art at this time. In addition to relying upon the assertion of a utility that would be considered to be specific, substantial, and credible, if at any time during the examination of a patent application it becomes readily apparent that the claimed invention has a well-established utility that is art recognized as specific, substantial, and credible, the invention would be considered to meet the utility requirement.

The written description requirement of 35 U.S.C. § 112, first paragraph, ensures that an applicant clearly convey all the information necessary to evidence that an applicant was in possession of the subject matter which is claimed for patent protection.

The written description examination guidelines are written in a technology neutral manner and apply to all types of inventions including products, processes, and claims drafted in product by process format. The basic question that is asked during the examination process is whether or not one skilled in the art would reasonably conclude that the inventor was in possession of the claimed invention at the time the application was filed. The guidelines emphasize that there is a strong presumption of the presence of an adequate written description of the invention and that the burden is on the USPTO to establish a *prima facie* case of lack of an adequate written description of the claimed invention. However, for example, in some instances, simply naming a novel compound without any disclosure of any related structural information will be insufficient evidence that an applicant had in their possession what is being claimed.

In biotechnology, an adequate written description of a DNA molecule might require a precise definition such as some structure, formula, chemical name, or physical properties. When considering whether an application for patent is supported by an adequate written description, the examiner will consider factors such as an actual reduction to practice of the claimed invention, deposits of biological materials, the presence or absence of drawings, disclosure of any complete or partial structures, discussions of physical,

chemical, and/or functional properties, structure/function correlations, discussions of methods of making what is claimed, and the level of skill and knowledge in the art. In addition, that which was conventional or well known to one skilled in the art need not be disclosed in detail. Thus, in less mature technologies, there will be a greater need for evidence to support a finding that the applicant was in possession of the claimed invention at the time of the filing of an application for patent.

Based upon these considerations, the examiner will make an initial determination of the presence or absence of an adequate written description. If after this review, the examiner concludes that the skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claim is not explicitly described in the specification, then the requirement for an adequate written description will be considered to be met.

The USPTO has provided examination guidelines to assist patent examiners and practitioners in making patentability determinations. The utility and written description guidelines are designed to provide a framework for consistent and high quality examination that will result in fair, reasoned, and appropriate patentability determinations. As always, each particular application is considered based upon its own merits, and the standards that are set forth by law as interpreted by the courts are applied evenly across all patent applications and technologies.

If you are interested in reviewing the examination guidelines addressed in this article, they may be found at the USPTO Web site (www.uspto.gov) under *Federal Register* Notices, in the *Federal Register* at 65 FR 1092 (January 5, 2001), or in the *Official Gazette* at 1242 OG 162 (January 30, 2001).

Registration of Domain Names as Trademarks - Looking Back, Looking Ahead

by Jessie N. Marshall, Office of the Commissioner for Trademarks

Over the last year or so and in various media, articles have appeared concerning the registration of domain names as trademarks. Some of the articles have been about the phenomenon itself, some have been about the nuts and bolts of the trademark registration process as it is applied to domain names, and some have been conjectures regarding the congruence of the increase in applications for trademark registration and the burgeoning of the Internet itself. This article will do none of those things. It will simply lay out some of the numbers behind the phenomenon and perhaps take an unofficial personal guess at where it may go next.

The United States Patent and Trademark Office received 28,552 applications through the end of the year 2000 that included .COM in the mark presented for registration. In the year 2000 alone, the USPTO received 12,840 of those applications. To those who say the .COM boom is over, they had better look again. It must be remembered that not all of the marks that represent domain names include the top level domain (TLD), that is, the .COM, .ORG, .EDU, etc. in the trademark application. Many will apply for only the second level domain (e.g., the XYZ in XYZ.COM.) So even these impressive figures only tell part of the story.

A further search on the USPTO automated search system reveals that 43,803 applications have included the term "Internet," "Web site," or "Web sites" in the identification of goods and services. It turns out that 38,695 of the applications that included one of those terms in the identification of goods or services did not include a .COM designation in the mark itself. Of course, not all of those applications were for domain names, but the analysis points to a fairly reasonable assumption that not all of the domain names that have been presented for registration have included the TLD in the mark itself.

Another interesting aspect of this figure is that it shows that the business of the Internet continues to thrive. Yes, many of the early .COM entities failed, merged or were bought out, but the Internet is clearly a permanent reality in our society and our economy. Of course, many applications that include the term "Internet," "Web site," or "Web sites" in the identification of goods and services are for marks that are also domain names. However, those that are not domain names are still related to activity on the Internet. These

marks may be for computer software used for accessing the Internet or creating activity on the Internet. They may be for consulting services relating to doing business on the Internet, or training services and manuals on how to most effectively use the Internet. Whatever the specific goods or services may be, the chances are good that any application that includes these terms in the identification of goods or services will be related to Internet activities. Although the key players on the Internet - the domain name entities - may be in the process of distilling to the strongest and most viable, the related goods and services that support this part of the economy are alive and well and applying for registration of their trademarks.

Where will it go from here? There may be an increase in filings in this area as the new TLDs go into use. Those new designations are .BIZ, .INFO, .NAME, .PRO, .AERO, .MUSEUM, and .COOP. As businesses and entities are created specifically to exist on the Internet, the TLD becomes an integral part of how they are recognized. Even if the designation doesn't carry significant trademark impact, it is part of the name of the entity. Therefore, many of them will apply to register their domain names as trademarks and will include the TLD as part of the mark. As of the writing of this article, the USPTO has received 49 applications that include the designation .BIZ, 54 with .INFO, 20 with .PRO, 2 with .NAME, 2 with .AERO and none with either .MUSEUM or .COOP. It will be interesting to see how this area develops as the new TLDs start their lives on the Internet.

Something to keep in mind - although 12,840 applications that included .COM in the mark were filed in 2000, this number represented a small percentage of the total of 284,454 applications that were filed in that year. Even though they are a small percentage of the total number of applications, the Internet-related filings represent a significant trend in trademark filings in the USPTO and perhaps the highest-profile type of mark that moves through this office.

One thing is for sure. So long as there is economic activity on the Internet, there will be applications in the USPTO to register the names and designs by which these entities are known. And there are no signs that there will be any abatement in the vigor of the Internet. Along with the Internet entities, the support activities and goods will continue to exist and grow and they, too, will add to the numbers of trademark applications that are related to Internet activity. The USPTO has been examining these marks consistent with the mandates of the Lanham Act. There have been only a few unique issues presented by these marks that have required new

decisions to be made regarding how to examine them under the Act. Domain names are interesting to work with and of great value to their owners, but in order for these designations to be registered as marks, they must fulfill all of the requirements of the Lanham Act.

USPTO Library and Employee Honored

by Maria Victoria Hernandez, Office of Public Affairs

The Scientific and Technical Information Center (STIC) of the United States Patent and Trademark Office has been named by the Library of Congress as the Federal Information Center of the Year. In addition, Darcy Bates, a STIC employee, was selected as Federal Library Technician of the Year.

USPTO's STIC was chosen from over 1,200 federal information facilities eligible to receive the award by the Federal Library and Information Center Committee of the Library of Congress, a national organization of federal libraries. Applicants were evaluated on their mission effectiveness, creativity and innovation in services and customer orientation. The Library Technician Award recognizes the winner's service excellence, technical competency, flexibility in adapting work methods and ability to deal with change. The Librarian of Congress, Dr. James Billington, will present the awards in a ceremony in late March.

The Scientific and Technical Information Center serves USPTO's 3,000 patent examiners from six specialized facilities located in the agency's technology centers. STIC has the most comprehensive collection of foreign patents in the United States, as well as a host of domestic and foreign non-patent literature. STIC staff also offers translation services. Last year, STIC staff performed over 22,000 prior art searches for patent examiners and provided examiners with the full text of more than 50,000 articles, foreign patents and books. STIC also provides desktop access to a range of electronic information resources, including 6,000 electronic journals and nearly 5,000 electronic books.

Faces of the USPTO

James A. Toupin, formerly Deputy General Counsel at the United States International Trade Commission, is the new General Counsel at the United States Patent and Trademark Office as of January 19, 2001. The General Counsel's Office is composed of the Office of General Law and the Office of the Solicitor and provides executive direction for the Board of Patent Appeals and Interferences, the Trademark Trial and Appeal Board, and the Office of Enrollment and Discipline.

Mr. Toupin also served as Assistant General Counsel for Litigation and Special Projects at the United States International Trade Commission from 1987 to 1994. Prior to his Government service, he was an associate at Memel, Jacobs, Pierno, Gersh & Ellsworth from 1985 to 1987, and at Covington & Burling from 1978 to1985. He graduated in 1973 cum laude from Stanford University where he earned a B.A in history and was a member of Phi Beta Kappa. Mr. Toupin obtained his J.D. in 1977 from the University of California at Berkeley, Boalt Hall School of Law, where he was editor of the California Law Review. He is admitted to practice in California and in the District of Columbia.

Bernard J. Knight, Jr. is the Deputy General Counsel for General Law. He provides legal counsel to the Under Secretary and represents the USPTO generally in matters other than those involving intellectual property issues. The General Law Office provides advice and written legal opinions on areas concerning the administration and management of the USPTO.

Prior to joining the USPTO, Mr. Knight was a Senior Trial Attorney

with the United States Department of Justice (DOJ). While at the DOJ, Mr. Knight received multiple Outstanding Awards for his achievements. Mr. Knight has litigated cases in many states including, Arizona, Colorado, Hawaii, Oregon, Nevada, and Nebraska.

As an Adjunct Professor of Law at DePaul University in Chicago, Illinois, Mr. Knight taught several classes in the Master of Laws in Taxation program. Before joining the DOJ, Mr. Knight worked at the law firms of Vinson & Elkins in Houston, Texas and Hopkins & Sutter in Chicago, Illinois. Mr. Knight has been a frequent public speaker for several organizations including, the Milwaukee Bar Association, the Houston Bar Association, the DePaul University Health Care Tax Law Institute and the Nebraska Hospital Association.

Mr. Knight received his J.D. degree from the University of Southern California in Los Angeles, California and a B.S.B.A. from Drake University in Des Moines, Iowa. He is currently a candidate in the Masters Degree in Developmental Psychology program at Johns Hopkins University.

John M. Whealan is the Deputy General Counsel for Intellectual Property Law and Solicitor for the United States Patent and Trademark Office. Mr. Whealan has been in the Solicitor's Office for over four years, previously holding the positions of Acting Deputy Solicitor and Associate Solicitor. The Office of the Solicitor has the primary responsibility of defending the decisions of the Board of Patent and Appeals and Interferences, the Trademark Trial and Appeal Board, the Under Secretary and Director, and other agency officials when challenged in the federal courts if the decision concerns a patent or trademark issue.

While in the Solicitor's Office, Mr. Whealan has argued more than 10, and written/edited briefs in more than 50, appeals before the U.S. Court of Appeals for the Federal Circuit. He has also worked on various district court cases involving the USPTO. In addition,

Mr. Whealan has worked with the Department of Justice on several intellectual property cases before the U.S. Supreme Court and other Circuit Courts.

Mr. Whealan is also an adjunct professor at both the Franklin Pierce Law Center and Chicago-Kent College of Law where he teaches an advanced seminar on the Federal Circuit.

Prior to joining the USPTO, Mr. Whealan was a staff attorney at the U.S. International Trade Commission (ITC). At the ITC, Mr. Whealan litigated several Section 337 investigations involving intellectual property matters.

Mr. Whealan has clerked both at the appellate and trial court levels, serving as law clerk to Judge Randal R. Rader of the Federal Circuit, and Judge James T. Turner of the U.S. Court of Federal Claims. Mr. Whealan has worked as a lawyer in private practice in New York.

Mr. Whealan received his Juris Doctorate from Harvard Law School, and holds both graduate and undergraduate degrees in Electrical Engineering. Mr. Whealan worked as a design engineer for General Electric Co. prior to attending law school.

Mr. Whealan is married to Elysa Joy Blacker who is a Senior Buyer for the Smithsonian Institution. They have a three year old daughter named Diana.

Helpful Hints

for Patent Applicants

The 20¢ Insurance Policy

by Dick Apley, Director, Office of Independent Inventor Programs

Recently, I received e-mail from an independent inventor bemoaning the fact that the USPTO charged him a surcharge of $65 (small entity fee) for missing parts of his application. He was insistent that he had included the alleged missing papers with his filing. After a long discussion regarding the scanning process done by the Office of Initial Patent Examination (OIPE), I educated the inventor on the 20-cent insurance policy.

If a self-addressed, stamped postcard (prepaid postcard, currently 20 cents) is submitted with a patent application, that postcard will be provided with both the receipt date and application number prior to returning it to the addressee. Although the filing receipt represents the official assignment by the USPTO of an application number and receipt date to a particular application, a properly itemized postcard serves as *prima facie* evidence that those items listed on that postcard were received in the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, in the situation referred to above, if our independent inventor submitted a postcard with his patent application, the identifying data on the postcard would have included the following:

a) applicant's name or alphanumeric identifier;
b) title of the invention;
c) number of pages of specification,
d) number of pages of claims,
e) number of sheets of drawing;
f) whether an oath or executed declaration is included and the number of pages submitted;
g) provisional application cover sheet (if applicable); and
h) amount and manner for paying the fee.

A return postcard should be attached to **each** patent application for

which a receipt is desired. The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, in the situation above, if the independent inventor merely listed on the postcard "a complete application" the inventor would have no evidence of the components of the application papers filed. Each separate component should be specifically and properly itemized on the postcard.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not submitted to the USPTO, the postcard will be stamped with an indication of the missing item(s).

The applicant should promptly review the postcard receipt to ensure that every item specifically denoted on the postcard was received by the USPTO. This is your 20-cent insurance policy.

USPTO 2001 Spring Video Conference Series

E-Learning Lecture Schedule

The Video Conference Center Lectures reflect the USPTO's current and largest introduction into e-learning for its patent examiner and public sector constituents. Public sector lectures are offered through the USPTO's videoconferencing facilities at partnership Patent and Trademark Depository Libraries in Sunnyvale, California; Detroit, Michigan; and Houston, Texas. Currently these are the only locations the lectures will be offered to the public.

The subjects offered mirror learning requirements in the ongoing in-house Practice and Procedures technical curriculum. Listed below is a schedule of upcoming courses for the next several months. Please remember that start times listed are Eastern Time. Each partnership PTDL site is in a different time zone, therefore you must check with them for accurate local starting times. Most lectures run about two hours, however some may go as long as three hours. The schedule of lectures is confirmed for participation at the time of publishing, however it is subject to change based upon agency needs.

TITLE	DATE	TIME	LECTURER
Petitions	March 15, 2001	1:00 PM	Brian Hearn
Trademark Trial and Appeal Board Issues	March 27, 2001	1:00 P.M.	Cindy Greenbaum/Gerard Rogers
PCT I	April 10, 2001	1:00 PM	Carol Bidwell
PCT II	April 12, 2001	1:00 PM	Carol Bidwell
Trademark Tips for Paralegals	April 24, 2001	1:00 PM	Janice Long/ Hope Slonim
112.2nd Paragraph	April 26, 2001	1:00 PM	Nelson Moskowitz
Novelty 35 USC 102	May 01, 2001	1:00 PM	Tom Will
Affidavits 37 CFR 1.31 & 1.32	May 10, 2001	1:00 PM	David Lacey
Re-Issue and Re-Exam	May 15, 2001	1:00 PM	Kenneth Schor/ Joe Narcavavge
Obviousness 35 USC 103	May 24, 2001	1:00 PM	David Moore
New Rule Changes	June 05, 2001	1:00 PM	Robert J. Spar
Response by Applicant	June 07, 2001	1:00 PM	Carlos Azpuru
P CT I	June 19, 2001	1:00 PM	Carol Bidwell
PCT II	June 21, 2001	1:00 PM	Carol Bidwell

Contact your closest partnership PTDL for information on times, registration fees, or to register:

Sunnyvale Center for Innovation, Invention and Ideas
Sunnyvale, California
Phone: (408) 730-7290

Great Lakes Patent and Trademark Center
Detroit, Michigan
Phone: (313) 833-3379

South Central Intellectual Property Partnership at Rice University
Houston, Texas
Phone: (713) 348-5196

VIDEOCONFERENCE COURSE DESCRIPTIONS

Patents

Affidavit Practice: 37 CFR 1.131 and 1.132:

The information provided in this session is a great benefit to attorneys/applicants because it teaches the USPTO's way of doing things. The lecture is designed to teach examiners the analytical skills needed to evaluate whether an affidavit filed under 37 CFR 1.131 may be used as evidence to swear behind a reference, and whether an affidavit filed under 37 CFR 1.132 may be used as evidence to overcome a ground of rejection or an objection. When attorneys/applicants know what is needed in each affidavit type, and when it is appropriate to employ an affidavit, prosecution can be much more effective, lending credence to the old saying "it ain't what you do but the way that you do it!"

Obviousness under 35 USC 103:

Understand the meaning of 35 USC 103. Learn to apply the standards used to establish a legal conclusion of obviousness. Treat the various issues that inevitably arise when applying 35 USC 103. By the end of this session, you should be able to recognize and understand the following concepts related to obviousness:

- The statute;
- Prima facie obviousness;
- The Graham test;
- Scope and content of prior art;
- Evidence of prior art comprising references, admissions and affidavits;
- Analogous art; and differences between the prior art and the claims at issue.

Attendees will also gain a level of skill in the pertinent art comprising:

- Motivation;
- Hindsight;
- Motivation different from applicant's;

- Art recognized equivalence for the same purpose;
- Physical incorporation;
- Destroying a reference;
- Changing principle of operation and number of references combined; and
- Secondary considerations comprising unexpected result; long felt need; and commercial success will also be discussed.

With all this valuable information, it is "obvious" that you need to take this class!

Novelty 35 USC 102:

Participants will learn to determine whether a reference qualifies as prior art under 35 USC 102 (a), (b), or (e) and determine whether a single reference teaches all the elements of a claimed invention.

Petitions:

Every patent attorney needs to know how to handle petitions expeditiously, efficiently and with a minimum of error. You will learn the basic principles of petition practice and the two main avenues of ex parte review – appeal and petition. Identify the various types and components of petitions handled in the Office of the Deputy Commissioner for Patent Examination Policy, as well as in the Examining Corp and the requirements that MUST be met to have a petition granted. Become more effective in your practice before the office by getting guidance on how to 1) avoid the most common errors that lead to petitions in the first place, and 2) avoid errors in the petitions themselves.

Changes to Patent Practice and Procedure - New Rules Changes

Changes to Patent Practice and Procedure - New Rules Changes is a comprehensive lecture covering primarily the rules changes of the American Inventors Protection Act of 1999, (AIPA), and the Patent Business Goals-Final Rule, (PBG-Final Rule). The first portion of the lecture highlights some of the significant changes to patent practice and procedure wrought by passage of the AIPA and its implementation. Topics include Patent Term Guarantee, the Request for Continued Examination Practice, Pre-Grant Publication (PG-Pub), and *Inter Partes* Reexamination. The first portion of the lecture also focuses on changes to 35 USC § 103(c) and 35 USC § 102(e) and § 374 made by the AIPA.

The second portion of *Changes to Patent Practice and Procedure - New Rules Changes* addresses some of the important rules changes as published in the PBG-Final Rule. These changes are part of the office's continuing efforts to streamline and simplify the process of applying for and obtaining patent protection for new inventions. The lecture will focus on those rules which best eliminate unnecessary requirements for applying for and obtaining a patent, remove impediments to electronic filing, reduce costs to the public and the office, and clarify previously complicated technical rules.

Lastly, a brief overview concerning other rules changes such as the

changes relating to unlocatable files and payment of USPTO fees by credit card will be provided, as well as an overview of significant practice changes such as OIPE review of drawings, Electronic Filing System (EFS) submissions, and PCT CD filings.

Reexam and Reissue

The lecture provides an overview of the *ex parte* reexamination and reissue programs established pursuant to the statutes (35 U.S.C. 251 and 35 U.S.C. 302-305), rules (37 CFR 1.172-1.179 and 37 CFR 1.510-1.552), and MPEP requirements governing reissue applications and *ex parte* reexamination proceedings, respectively. The objectives include enabling the practitioner to understand reissue practice as a post-issuance activity for correcting errors in issued patents, and reexamination practice as a litigation alternative. The overview will include some policy highlights of the office's implementation efforts for optional *inter partes* reexamination. The attendee will learn:

- To understand how the key provisions of the statutes and rules apply to the examination process of reissues and *ex parte* reexaminations;
- To understand the instances where patents are eligible for *inter partes* reexamination;
- To understand the primary similarities and differences between the examinations of reissue applications, *ex parte* reexamination proceedings, and regular utility applications;
- To understand the criteria for granting a request for reexamination;
- To understand the scope of *ex parte* reexamination proceedings; and
- To recognize the importance of and the emphasis on a reissue oath/declaration and to be able to distinguish such from the oath or declaration of a utility application.

35 USC 112-2 paragraph, Rejections Not Based on Prior Art:

This session will analyze the claims to determine whether or not one skilled in this art can determine the metes and bounds of a claim with a fair degree of certainty. Attendees will be taught to understand the criteria for determining clear and distinct claim language, and understand the policy reasons for 35 USC 112-2. The session also enables the practitioner to understand appropriateness of rejections in accordance with 35 USC 112.

Response by Applicant:

It is very important to understand the proper form when dealing with the USPTO. It makes life easier and helps avoid delays. This session enables the attendee to determine when a response to an Office Action is correct and complete. It will guide the applicant on the proper course of action to be

taken when the response is incorrectly filed. To state it simply, it covers the who, what and when of responses-WHO is the proper person to file? WHAT is considered a proper response? And WHEN is it due?

The Patent Cooperation Treaty:

This is a two-part lecture on the Patent Cooperation Treaty. Representatives from the PCT Special Programs Office of the USPTO teach a basic seminar on practice and procedures of the Patent Cooperation Treaty from filing an international application to entering the national phase in the USPTO.

Patent Cooperation Treaty (PCT) Part I:

The first session starts with an overview of the PCT process including the international phase and the national phase as well as the advantages of using PCT for filing foreign patent applications. Next the participants are given detailed information on how to file an international application. Participants are taught how to properly fill out a PCT Request form including information on using PCT –EASY, the self-validating software for generating the Request.

Patent Cooperation Treaty (PCT) Part II:

The second session continues with information on filing a Demand for International Preliminary Examination. Next participants learn about national stage entry in the US under 35 USC 371 and an alternative strategy for filing a US patent based upon the international application. The session ends with helpful hints on the PCT process including how to record changes in the applicant, how to delay or prevent publication of the international application, and a discussion of important forms that should be monitored during the international phase.

TRADEMARKS

Trademark Tips for Paralegals:

This seminar will provide an explanation of the trademark process aimed at non-attorney legal professionals. Legal staff of the Office of the Commissioner for Trademarks will provide an explanation of the trademark process, including an overview of the office and updates on pendency for new applications. They will provide insight on why trademark applications go abandoned; tips to avoid abandonment; and what to do when your application is abandoned. They will briefly explain the difference between a petition and an appeal and a petition and a request for reinstatement. They will also provide a list of contacts at the PTO and other handouts, to help you get the right answer, right away.

Trademark Trial and Appeal Board Issues:

Topics for discussion include: the pre-trial phase of opposition and cancellation proceedings including pleadings and discovery, the trial and decision phases of opposition and cancellation proceedings including the submission of trial evidence and how recently proposed rule changes would affect practice before the TTAB.

Patents Customer 2001 Workshops

on Electronic Government Initiatives and the American Inventors Protection Act

The USPTO has scheduled educational workshops in

- Denver, CO (April 2-3, 2001),
- Stillwater, OK (April 5-6),
- Grand Rapids, MI (May 14-15) and
- Troy, MI (May 17-18)

to introduce the agency's patent-related electronic government initiatives and to explain rules and regulations implementing recent changes to patent law.

The electronic government segment of the workshop will show customers how to file a patent application online, using the agency's state-of-the-art electronic filing software. The system assembles all application components, calculates fees, validates application content, compresses, encrypts and transmits the filing to USPTO. The agency uses the latest public key infrastructure technology to guarantee the security of electronic applications. The session will also demonstrate how to access patent application information on line.

The second segment of the workshop will explain new USPTO procedures for implementing the American Inventors Protection Act of 1999. This segment will focus on procedures for Request for Continued Examination, Patent Term Adjustment, 18-Month Publication, and Inter Partes Reexamination. There will also be discussions about significant changes in the Patent Business Goals final rule, which simplifies patent application filing.

Reservation and contact information for USPTO's Patents Customer 2001 Program workshops:

Denver:

Sponsored by:	Denver Public Library Patent and Trademark Depository Library
Location:	13th and Broadway
Date/Time:	Monday, April 2, 2001, 9:00 a.m. - 4:30 p.m. Tuesday, April 3, 2001, 9:00 a.m. - 4:30 p.m.
Contact:	(720) 865-1733

Stillwater:
Sponsored by: Patent and Trademark Library
Location: Oklahoma State University
Date/Time: Thursday, April 5, 2001, 9:00 a.m. - 4:30 p.m.
Friday, April 6, 2001, 9:00 a.m. - 4:30 p.m.
Contact: (405) 744-7086

Grand Rapids:
Sponsored by: Michigan State Bar Intellectual Property Section
Location: Amway Grand Hotel
Date/Time: Monday, May 14 , 2001, 9:00 a.m. - 4:30 p.m.
Tuesday, May 15, 2001, 9:00 a.m. - 4:30 p.m.
Contact: Catherine S. Collins
Phone: (616) 975-5506
Fax: (616) 975-5505
E-mail: Collins@vglb.com

Troy:
Sponsored by: Michigan State Bar Intellectual Property Section
Location: Troy Marriott
Date/Time: Thursday, May 17 , 2001, 9:00 a.m. - 4:30 p.m.
Friday May 18, 2001, 9:00 a.m. - 4:30 p.m.
Contact: Beverly Bunting
Phone: (248) 647-6000
Fax: (248) 647-5210
E-mail: bbunting@patlaw.com

Additional information for USPTO's Patents Customer 2001 Program workshops is available on USPTO's Website at www.uspto.gov (click on Patents Customer Outreach 2001 Program). The site will be updated with additional workshop locations as they are scheduled.

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